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09/028,718 02/24/98 CAIRNS

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HILL & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606

LM02/0805

EXAMINER

YOUNG, J.

ART UNIT

PAPER NUMBER

2764

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/028,718

Applicant(s)

Cairns

Examiner
John L. Young

Group Art Unit
2764



☒ Responsive to communication(s) filed on Feb 24, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 & 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DRAWING OBJECTIONS

1. This application has been filed with drawings that have been objected to by the PTO draftsman (see PTO 948); therefore, said drawings are considered informal and acceptable for examination purposes only. "The applicant is required to submit acceptable drawings within three months from the mailing of the 'Notice of Allowability.'" (See 37 CFR 1.85(c)).

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1, 3, 4, 5, 7, 8, 10, 11, 12, 13, 14, 15 & 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Small 5,791,991 (8/11/98) [f/d 11/15/95] (herein referred to as "Small").

As per claim 1, Small col. 2, ll. 59-61 discloses "*an interactive consumer product promotion method. . . .*"

Small FIG. 2, el. 100; FIG. 8; and col. 3, ll. 40-47 discloses "*a custom personalized form . . . which allows the consumer to submit . . . codes or other proofs. . . .*" and shows elements that suggest "receiving said code from said purchaser. . . . [and] obtaining purchaser information from said purchaser. . . ."

Small col. 7, ll. 1-15 shows elements that suggest "informing said purchaser whether said purchaser has won a prize based on said code."

Small FIG. 1, elements 11, 13 & 14 suggest "a network address. . . ."

Small does not explicitly show "a network address. . . ."

It would have been obvious to one of ordinary skill in the art at the time of the invention that FIG 1. elements 11, 13 & 14, i.e., a "WEBSITE" an "INTERNET ACCESS PROVIDER" and the "PUBLIC TELEPHONE SYSTEM" would have been selected in accordance with including "a network address. . . ." because such selection would have provided "*a more desirable and convenient method of promoting the sale of consumer products. . . .*" (see Small col. 2, ll. 37-42).

As per claims 3, 4 & 5, Small shows the process as claimed in claim 1. (See the

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rejection of claim 1 supra).

Small FIG. 1, elements 11, 13 & 14 discloses a "WEBSITE" an "INTERNET ACCESS PROVIDER" and the "PUBLIC TELEPHONE SYSTEM." The examiner interprets the disclosure of a "WEBSITE" as suggesting "a world wide web address in the [Internet] [ref. Claim 3]." The examiner interprets the disclosure of an "INTERNET ACCESS PROVIDER" as suggesting both "a wide area network address [ref. Claim 4]" and "an address in an on-line service [ref. Claim 5]."

Small does not explicitly show "a world wide web address in the . . . a wide area network address . . . [and] an address in an on-line service. . . ."

It would have been obvious to one of ordinary skill in the art at the time of the invention that FIG 1. elements 11, 13 & 14, i.e., a "WEBSITE" an "INTERNET ACCESS PROVIDER" and the "PUBLIC TELEPHONE SYSTEM" would have been selected in accordance with ""a world wide web address in the . . . a wide area network address . . . [and] an address in an on-line service. . . ." because such selection would have provided "*a more desirable and convenient method of promoting the sale of consumer products. . . .*" (see Small col. 2, ll. 37-42).

As per claim 7, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small col. 2, ll. 5-10 shows elements that suggest "said product is a catalog."

Small does not explicitly show that "said product is a catalog."

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It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure “to redeem prices selected from catalogs. . . .” would have been selected in accordance with “said product is a catalog. . . .” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claims 8 & 10, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 8; and FIG. 2 shows elements that suggest “obtaining said purchaser’s name and street address.” (Ref. Claim 8).

Small FIG. 8; and FIG. 2 shows elements that suggest “obtaining said purchaser’s telephone number.” (Ref. Claim 10).

Small does not explicitly show “obtaining said purchaser’s name and street address [ref. Claim 8] . . . [and] telephone number [ref. Claim 10].”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosures in FIG. 8 and FIG.2 would have been selected in accordance with “obtaining said purchaser’s name and street address [ref. Claim 8]. . . . [and] telephone number. . . . [ref. Claim 10]” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

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As per claim 11, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 8; and FIG. 2 shows elements that suggest “obtaining said purchaser’s postal zip code. . . .”; however,

Small does not explicitly show “obtaining said purchaser’s postal zip code.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure in FIG. 8 would have been selected in accordance with “obtaining said purchaser’s postal zip code. . . .” because it was notoriously well known in the art to include a postal zip code with an entities name and street address; furthermore, such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claim 12, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small col. 1, ll. 18-21 discloses “discount coupons. . . .”

Small does not explicitly show “providing the purchaser with a discount on subsequent purchases of said product.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that “discount coupons. . . .” would have been selected in accordance with “providing the purchaser with a discount on subsequent purchases of said product. . . .” because such selection would have provided “*a more desirable and convenient method of*

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promoting the sale of consumer products. . . ." (see Small col. 2, ll. 37-42).

As per claim 13, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 1 & FIGs. 3-7 show elements that suggest "providing the purchase [sic] wit a game to play while connected to said network address."

Small does not explicitly show "providing the purchase [sic] with a game to play while connected to said network address."

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosures of FIG. 1 & FIGs. 3-7 would have been selected in accordance with "providing the purchase [sic] with a game to play while connected to said network address. . . ." because such selection would have provided "*a more desirable and convenient method of promoting the sale of consumer products. . . .*" (see Small col. 2, ll. 37-42).

As per claim 14, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 show elements that suggest "collecting purchaser identity information in a database."

Small does not explicitly show "collecting purchaser identity information in a database."

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It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosures of FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 would have been selected in accordance with “collecting purchaser identity information in a database” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claim 15, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 show elements that suggest “performing research on said database.”

Small does not explicitly show “performing research on said database.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosures of FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 would have been selected in accordance with “performing research on said database. . . .” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claim 16, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 show elements that suggest

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“sending promotional material to purchaser’s in said database.”

Small does not explicitly show “sending promotional material to purchaser’s in said database.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosures of FIG. 1; FIG. 2; FIG. 8 and col. 5, ll. 1-13 would have been selected in accordance with “sending promotional material to purchaser’s in said database. . . .” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

3. Claims 2, 18, 19 & 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Small in view of Dickert 5,149,202 (9/22/92) (herein referred to as “Dickert”) and further in view of Toader 5,806,043 (9/8/98) [f/d 11/6/95] (herein referred to as “Toader”).

As per claim 2, Small shows the method of claim 1. (See the rejection of claim 1 supra).

Small does not explicitly show “incorporating a card into packaging of said product. . . .”

Dickert col. 1, ll. 29-33 discloses “*coupons . . . are often dropped into a bag or carton. . . .*”

Dickert proposes coupon modifications that would have applied to the product promotion teachings of Small. It would have been obvious at the time the invention was

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made to a person having ordinary skill in the art to add the modifications taught by Dickert to Small, because such modifications would have provided a means for “*the premium material to be easily inserted in the . . . pouch. . .*” (See Dickert col. 2, ll. 6-7).

Small does not explicitly show “said card including said network address. . . .”

Toader col. 4, ll. 61-63 discloses “[*the*] . . . *Electronic mail address can be provided as a feature of the log-on or registration procedure. . . .*” The examiner interprets this disclosure as suggesting “said card including said network address. . . .”

Toader proposes e-mail modifications that would have applied to the product promotion teachings of Small. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the modifications taught by Toader to Small, because such modifications would have provided a means for “*distributing to customers . . . ‘free’ on-line help. . . .*” (See Toader col. 2, ll. 12 & 49).

As per claim 18, Small shows “a method for promoting a product. . . .” (See the rejection of claim 1 supra).

Small in view of Toader shows elements that suggest “providing a plurality of cards each marked with an Internet address and respective unique codes. . . .” (See the rejection of claim 2 supra).

Small in view of Dickert shows elements that suggest “incorporating said plurality of cards into packaging of a corresponding plurality of product units, each of said cards

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being incorporated into one of said product unit packages. . . . providing said product units for sale to purchasers. . . . (See the rejection of claim 1 supra);

“providing a site at said Internet address for access by said purchasers. . . .” (See the rejection of claim 17 supra);

“receiving connections from said purchasers at said site. . . .” (See the rejection of claim 17 supra);

“obtaining personal information from said purchasers at said site. . . .” (See the rejections of claims 8 -11 supra);

“receiving . . . unique codes. . . . and informing each . . . purchasers of status. . . .” (See the rejections of claim 1 supra).

As per claim 19, Smalls shows “status is selected from statuses of winning and non-winning. . . .” (See the rejection of claims 1 & 18).

Claim 20 is rejected for the same reasons as claim 19.

4. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Small in view of Sloane 5,918,211 (6/29/99) (herein referred to as “Sloane”).

As per claim 6, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small does not explicitly show “product for sale at a retail store.”

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Sloane in the Abstract and FIG. 9 shows “*the point-of-purchase [is] in a retail store. . . .*”

Sloane proposes “*retail store*” modifications that would have applied to the teachings of Small. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the modifications taught by Sloane to Small, because such modifications would have provided a means for “*providing consumers with discount and other promotional information at the point-of-purchase.*” (See Sloane col. 2, ll. 53-55).

5. Claims 9 & 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Small in view of Toader.

As per claim 9, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small does not explicitly show “obtaining said purchaser’s e-mail address.”

Toader col. 4, ll. 61-63 discloses “[*the*] . . . *Electronic mail address can be provided as a feature of the log-on or registration procedure. . . .*” The examiner interprets this disclosure as suggesting “said card including said network address. . . .”

Toader proposes e-mail modifications that would have applied to the product promotion teachings of Small. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the modifications taught by Toader to Small, because such modifications would have provided a means for “*distributing to*

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customers . . . 'free' on-line help. . . . (See Toader col. 2, ll. 12 & 49).

As per claim 17, Small shows the process as claimed in claim 1. (See the rejection of claim 1 supra).

Small does not explicitly show "admitting said purchaser to said secure area upon entry of a valid code."

Toader col. 2, ll. 17-25 discloses "*Internet entry Server is programmed to recognize the PIN number as entitling the user to a limited prepaid or 'free' . . . access time for on-line . . . services.*"

Toader proposes secure area modifications that would have applied to the product promotion teachings of Small. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to add the modifications taught by Toader to Small, because such modifications would have provided a means for "*distributing to customers . . . 'free' on-line help. . . .*" (See Toader col. 2, ll. 12 & 49).

CONCLUSION

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Any response to this action may be sent via facsimile to either:

(703) 308-9051 (for formal communications marked EXPEDITED)

Serial Number: 09/028,718

(Cairns)

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PROCEDURE), or

(703) 308-5397 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Sixth floor Receptionist
Crystal Park II
2121 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, may be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young
Patent Examiner


James P. Trammell
Supervisory Patent Examiner
Technology Center 2700

August 1, 1999